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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/751,801	12/29/2000	Scott D. Leapman	1957	5937

30408 7590 09/30/2005	EXAMINER
GATEWAY, INC. ATTN: PATENT ATTORNEY 610 GATEWAY DR. MAIL DROP Y-04 N. SIOUX CITY, SD 57049	LASTRA, DANIEL

ART UNIT	PAPER NUMBER
3622	

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	09/751,801	LEAPMAN ET AL.
	Examiner	Art Unit	
	DANIEL LASTRA	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>11 July 2005</u>.
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5,7-22 and 24-49* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-5, 7-22 and 24-49* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____ .

DETAILED ACTION

1.   Claims 1-5, 7-22 and 24-49 have been examined. Application 09/751,801 (SYSTEM AND METHOD FOR TARGETED ADVERTISING) has a filing date 12/29/2000.

Response to Amendment

2.   In response to Advisory Action filed 04/08/2005, the Applicant filed an RCE on 07/11/2005, which amended claims 1, 14, 19, 28, 33 and cancel claims 6 and 23.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5, 7-22 and 24-43 and 45-49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dowling (US 6,522,875) in view of Marwell (US 6,404,884).

As per claims 1, 14, 19 and 28, Dowling teaches:

A method for broadcast advertising to a mobile communication device, comprising the steps of:

storing acceptance data in the communication device (see Dowling column 9, line 40 – column 10, line 40);

modifying the acceptance data by integrating at least one entry from a input-output module (see Dowling column 9, lines 40-65; figure 2, item 210, 225);

receiving by the communication device a broadcast advertisement containing advertisement data and comparing the advertisement data to the acceptance data to obtain a comparison result (see Dowling column 9, line 40 – column 10, line 40)

wherein the step of modifying the acceptance data includes converting the at least one entry from an input device into at least one product that corresponds to the at least one entry, and adding the at least one product to the acceptance data to accept advertisements for the at least one product (see Dowling column 9, lines 40-65; column 14, lines 57-67). Dowling fails to teach that said input-output module is a *personal information manager.* However, Marwell teaches in column 1, lines 20-35 that "Society's demand for virtually instantaneous access to information, and the need to quickly contact others is constantly increasing. To meet this demand, personal information manager (PIM) software for various types of computers, personal digital assistants (PDA) and global communication networks, such as the Internet, have been developed which facilitate access to data. For example, a person may have contact and telephone numbers stored in their PDA or electronic organizer, such that they can quickly determine the phone number of the person they wish to reach. Similarly, they may have a PIM database on their laptop which contains the same information, such that the PIM and PDA databases are harmonized; i.e., synchronized. Recently developed Internet software allows a user to harmonize a PIM contact information database with an Internet web site". Dowling teaches in column 17, lines 60-67 that "In another example the mobile unit 105 is implemented as a palm-pilot or personal digital assistant computer". Therefore, it would have been obvious to a person of ordinary skill in the art

at the time the application was made, to know that <u>Dowling</u>'s PDA mobile device would have a PIM software installed in said device, as taught by <u>Marwell</u>, which would allow users to input preference or acceptance data in said PDA. <u>Dowling</u> would have been motivated to include a PIM software in a PDA device in view of society's demand for virtually instantaneous access to information and to make it easier to access and input data into said PDA.

As per claims 2, 16, 20, 30 and 32, <u>Dowling</u> teaches:

The method of claim 1, wherein the broadcast advertisement is received by the communication device through a wireless communication channel (see column 8, lines 25-45).

As per claims 3 and 21, <u>Dowling</u> teaches:

The method of claim 2, wherein the broadcast advertisement is received by the communication device through one of: a radio transmission, a television transmission, a Bluetooth signal, and an infrared signal (see column 8, lines 25-35).

As per claim 4, <u>Dowling</u> teaches:

The method of claim 1, wherein the broadcast advertisement is received by the communication device from one of a billboard and a storefront (see column 10, lines 10-40; column 12, lines 60-67).

As per claims 5, 22 and 31, <u>Dowling</u> teaches:

The method of claim 1, wherein the acceptance data comprises preferences for accepting broadcast advertisements specified by a user of the communication device (see column 9, line 40 – column 10, line 39).

As per claims 7, 18 and 24, Dowling teaches:

The method of claim 1, further comprising the step of displaying the broadcast advertisement on the communication device based on the comparison result (see column 9, line 40 – column 10, line 40).

As per claims 8 and 25, Dowling teaches:

The method of claim 1, further comprising the step of storing the broadcast advertisement on the communication device based on the comparison result (see column 10, lines 10-40; column 12, lines 24-31).

As per claim 9, Dowling teaches the method of claim 8, but fails to teach further comprising the steps of: reading deletion data in a stored advertisement, wherein the deletion data indicates criteria for deleting the stored advertisement; and deleting the stored advertisement from the communication device based on the deletion data. However, Marwell teaches in column 1, lines 20-35 that "Society's demand for virtually instantaneous access to information, and the need to quickly contact others is constantly increasing. To meet this demand, personal information manager (PIM) software for various types of computers, personal digital assistants (PDA) and global communication networks, such as the Internet, have been developed which facilitate access to data. For example, a person may have contact and telephone numbers stored in their PDA or electronic organizer, such that they can quickly determine the phone number of the person they wish to reach. Similarly, they may have a PIM database on their laptop which contains the same information, such that the PIM and PDA databases are harmonized, i.e., synchronized. Recently developed Internet software allows a user

to harmonize a PIM contact information database with an Internet web site". Dowling

teaches in column 17, lines 60-67 that "In another example the mobile unit 105 is

implemented as a palm-pilot or personal digital assistant computer". Therefore, it would

have been obvious to a person of ordinary skill in the art at the time the application was

made, to know that Dowling's PDA mobile device would have a PIM software installed

in said device, as taught by Marwell, which would allow users to input preference or

acceptance data in said PDA. Dowling would have been motivated to include a PIM

software in a PDA device in view of society's demand for virtually instantaneous access

to information and to make it easier to access and input data into said PDA.

As per claim 10, Dowling teaches:

The method of claim 1, further comprising the step of outputting a notification

signal to a user of the communication device if comparison of the advertisement data to

the acceptance data is accepted (see column 11, lines 25-54).

As per claims 11, 15 and 29, Dowling teaches:

The method of claim 1, further comprising the step of sending an indicator signal

to a source of the broadcast advertisement, wherein the indicator signal notifies the

source that the communication device is within a broadcast range of the broadcast

advertisement (see column 11, lines 25-40).

As per claims 12 and 26, Dowling teaches:

The method of claim 1, further comprising the step of communicating through the

communication device with a wireless positioning system (see column 11, lines 25-40).

As per claims 13 and 27, Dowling teaches:

The method of claim 12, wherein the wireless positioning system is GPS (see column 11, lines 25-40).

As per claims 17 and 48, Dowling teaches the method of claim 14, but fails to teach further comprising the step of modifying the preferences for selecting advertisements specified by the user of the communication device by integrating entries from a personal information manager. However, Marwell teaches in column 1, lines 20-35 that "Society's demand for virtually instantaneous access to information, and the need to quickly contact others is constantly increasing. To meet this demand, personal information manager (PIM) software for various types of computers, personal digital assistants (PDA) and global communication networks, such as the Internet, have been developed which facilitate access to data. For example, a person may have contact and telephone numbers stored in their PDA or electronic organizer, such that they can quickly determine the phone number of the person they wish to reach. Similarly, they may have a PIM database on their laptop which contains the same information, such that the PIM and PDA databases are harmonized, i.e., synchronized. Recently developed Internet software allows a user to harmonize a PIM contact information database with an Internet web site". Dowling teaches in column 17, lines 60-67 that "In another example the mobile unit 105 is implemented as a palm-pilot or personal digital assistant computer". Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Dowling's PDA mobile device would have a PIM software installed in said device, as taught by Marwell, which would allow users to input preference or acceptance data in said PDA. Dowling would

have been motivated to include a PIM software in a PDA device in view of society's demand for virtually instantaneous access to information and to make it easier to access and input data into said PDA.

Claim 33 contains the same limitation as claims 1, 5 and 7 therefore the same rejection is applied.

Claim 34 contains the same limitation as claim 11 therefore the same rejection is applied.

Claim 35 contains the same limitation as claim 2 therefore the same rejection is applied.

Claim 36 contains the same limitation as claim 5 therefore the same rejection is applied.

Claim 37 contains the same limitation as claim 12 therefore the same rejection is applied.

As per claim 38, Dowling teaches:

The method of claim 1, wherein the advertisement data of the broadcast advertisement is capable of generating a display of an advertisement on the communication device (see column 4, lines 45-62).

As per claim 39, Dowling teaches:

The method of claim 1, wherein the advertisement data of the broadcast advertisement is capable of generating a display of an advertisement on the communication device without the communication device receiving additional data (see column 9, lines 55-65).

As per claim 40, <u>Dowling</u> teaches:

The method of claim 1, further comprising the step of displaying an advertisement on the communication device generated from the advertisement data if the comparison result indicates that the broadcast advertisement meets the acceptance data (see column 9, lines 40-65).

As per claim 41, <u>Dowling</u> teaches:

The method of claim 40, further comprising the step of rejecting the broadcast advertisement for display on the communication device if the comparison result indicates that the broadcast advertisement does not meet the acceptance data (see column 9, lines 40-65).

As per claim 42, <u>Dowling</u> teaches:

The method of claim 1, wherein the advertisement data includes at least one of: a company name, a brand name, information about a product, information about a service, price information, and a deadline for a special offer (see column 4, lines 20-30).

As per claim 43, <u>Dowling</u> teaches:

The method of claim 1, wherein the acceptance data includes at least one of: a company name, a brand name, product information, service information, price information, and a deadline for a special offer (see column 4, lines 20-30).

As per claim 45, <u>Dowling</u> teaches:

The method of claim 1, wherein the step of storing the acceptance data on the communication device comprises manually entering the acceptance data on the communication device by the user (see column 17, lines 45-60).

As per claim 46, <u>Dowling</u> teaches:

The method of claim 1, wherein the step of storing the acceptance data on the communication device comprises selecting by the user the acceptance data from a predetermined list of acceptance data on the communication device (see column 10, lines 59-61).

As per claim 47, <u>Dowling</u> teaches:

The method of claim 1, wherein the step of storing the acceptance data on the communication device comprises selecting by the user acceptance data from a template of acceptance data on the communication device (see column 10, lines 55-61; column 11, lines 25-54).

As per claim 49, <u>Dowling</u> teaches:

The method of claim 48, wherein the data from the personal information, manager includes an event, and the acceptance data created from the data from the personal information manager regarding the event causes acceptance of broadcast advertisements related to the event (see Dowling column 11, lines 1-54; column 14, lines 57-67).

Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Dowling</u> et al (U.S. 6,522,875) in view of <u>Marwell</u> (US 6,404,884) and further in view of <u>McAuliffe</u> et al (U.S. 5,838,790).

As per claim 44, <u>Dowling</u> teaches:

The method of claim 1, but fails to teach wherein the broadcast advertisement includes an expiration date upon which the broadcast advertisement is purged from the

communication device. However, McAuliffe teaches a system where ads are purged from the communication device upon detecting that the ad had expired (see figure 5). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Dowling would delete the ads from the mobile unit upon detecting that the ads had expired, as taught by McAuliffe. Dowling would have been motivated to delete the ads stored in a mobile device upon detecting that said ads had expired in order to free memory space from said mobile device and allows new advertisements to be stored in said device.

Response to Arguments

4. Applicant's arguments filed 07/11/2005 have been fully considered but they are not persuasive. Dowling teaches a mobile device (i.e. PDA) which allows a user to input preference data and where said preference data is used to filter received broadcast data, similar to Applicant's claimed invention.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The Examiner's Right fax number is 571-273-6720.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel Lastra
September 14, 2005

/RETTA YEHDEGA
PRIMARY EXAMINER